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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,528

06/16/2006

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

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1794

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,528	Applicant(s) DESROUSSEAU ET AL.	
	Examiner Betelhem Shewareged	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2 and 4-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/578,397 in view of Plank et al. (US 3,816,342). Current claims 1 and 12-15 correspond to claim 1 of '397, where an ink jet recording element comprises a support and an ink receiving layer comprising an aluminosilicate polymer. Current invention does not teach the use of chelating agent in making the aluminosilicate polymer. However, Plank teaches the use of a chelating agent in preparing an aluminosilicate polymer (col. 19, line 39). At the time of the invention it would have been obvious to combine the chelating agent of Plank with the invention of

Art Unit: 1794

'397, and the motivation would be, as Plank suggests, improving attrition resistance of the product (col. 19, line 37). Current claim 2 corresponds to claim 2 of '397. Current claims 4-11 correspond to claims 3-10 of '397, respectively. Current claim 16 corresponds to claim 11 of '397, where the ink receiving layer comprising at least 5 wt% of aluminosilicate polymer wherein this value overlaps with the value of 5-95 wt%.

5. This is a provisional obviousness-type double patenting rejection.

6. Claims 1, 2 and 4-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 15-17 of copending Application No. 10/578,813 in view of Plank et al. (US 3,816,342). Current claims 1 and 12-15 correspond to claim 1 of '813, where an ink jet recording element comprises a support and an ink receiving layer comprising a binder and an aluminosilicate polymer. Current invention does not teach the use of chelating agent in making the aluminosilicate polymer. However, Plank teaches the use of a chelating agent in preparing an aluminosilicate polymer (col. 19, line 39). At the time of the invention it would have been obvious to combine the chelating agent of Plank with the invention of '813, and the motivation would be, as Plank suggests, improving attrition resistance of the product (col. 19, line 37). Current claim 2 corresponds to claim 2 of '813. Current claims 4-10 correspond to claims 3-9 of '813, respectively. Current claim 11 corresponds to claim 15 of '813. Current claim 16 corresponds to claim 16 of '813, where the ink receiving layer comprising at least 5 wt% of aluminosilicate polymer

Art Unit: 1794

wherein this value overlaps with the value of 5-95 wt%. Current claim 17 corresponds to claim 17 of '813.

7. This is a provisional obviousness-type double patenting rejection.

8. Claims 1, 2 and 4-6, 9-15 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 15-17 of copending Application No. 10/563,693 in view of Plank et al. (US 3,816,342). Current claims 1 and 12-15 correspond to claim 1 of '693, where an ink jet recording element comprises a support and an ink receiving layer comprising a binder and an aluminosilicate polymer. Current invention does not teach the use of chelating agent in making the aluminosilicate polymer. However, Plank teaches the use of a chelating agent in preparing an aluminosilicate polymer (col. 19, line 39). At the time of the invention it would have been obvious to combine the chelating agent of Plank with the invention of '693, and the motivation would be, as Plank suggests, improving attrition resistance of the product (col. 19, line 37). Current claim 2 corresponds to claim 8 of '693. Current claims 4 and 5 correspond to claim 9 of '693. Current claim 6 corresponds to claim 10 of '693. Current claims 9 and 10 correspond to claims 11 and 12 of '693, respectively. Current claim 11 corresponds to claim 17 of '693. Current claim 17 corresponds to claim 18 of '693.

9. This is a provisional obviousness-type double patenting rejection.

Art Unit: 1794

10. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10, 16-21, 23 and 24 of copending Application No. 10/521,898. Current claim 1 corresponds to claims 1 and 17 of '898, where an ink jet recording element comprises a support and an ink receiving layer comprising a binder and an aluminosilicate polymer, and claim 17 of '898 recites the addition of a chelating agent. Current claims 2-10 correspond to claims 2-10 of '898, respectively. Current claim 11 corresponds to claim 16 of '898. Current claim 12 corresponds to claim 18 of '898. Current claims 13-15 correspond to claims 19-21 of '898, respectively. Current claims 16 and 17 correspond to claims 23 and 24 of '898, respectively.

11. This is a provisional obviousness-type double patenting rejection.

12. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/522,006. Current claim 1 corresponds to claims 1 and 12 of '006, where an ink jet recording element comprises a support and an ink receiving layer comprising a binder and an aluminosilicate polymer, and claim 17 of '006 recites the addition of a chelating agent. Current claims 2-11 correspond to claims 2-11 of '006, respectively. Current claims 12-17 correspond to claims 13-18 of '006.

13. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (EP 1 184 193 A2) in view of Poncelet et al. (US 5,888,711) and Plank et al. (US 3,816,342).

16. Claims 1-15: Campbell teaches an ink jet recording element comprising a substrate and a porous image receiving layer (abstract). The image receiving layer comprises a binder [0031] and organic particles [0030]. Campbell does not teach the organic particle comprises an aluminosilicate. However, Poncelet teaches a coating composition to be provided on a support (col. 2, line 26), wherein the coating composition comprises aluminosilicate polymer obtained from aluminum and silicon alkoxide in a presences of aqueous alkali, wherein the Al molar concentration being maintained in the range of 0.0005-0.02, Al/Si molar ratio between 1 and 3 (col. 1, lines 55-63) and the amount of the alkali, in moles, is between 2 and 3 times the amount of aluminum (col. 3, line 26). The aluminum, silicone alkoxide and aqueous alkali are mixed before heating (col. 1, lines 58-63), and byproducts such as residual ions are eliminated before coating the coating composition (col. 2, line 1). The coating composition does not contain a binder. The alkali comprises sodium or potassium {meets instant claim 2} (col. 3, line 20). The Al molar concentration being maintained in

Art Unit: 1794

the range of 0.0005-0.02 {meets instant claims 4 and 5} (col. 1, lines 61 and 62). The amount of the alkali, in moles, is between 2 and 3 times the amount of aluminum {meets instant claims 6-8} (col. 3, line 26). Aluminum halide is an example of the aluminum to obtain the aluminosilicate polymer and tetraethylorthosilicate is an example of the silicon alkoxide to obtain the aluminosilicate polymer {meets instant claims 9-11} (col. 5, lines 21-25). Poncelet does not teach the use of a chelating agent in preparing the aluminosilicate. However, Plank teaches the use of a chelating agent in preparing an aluminosilicate polymer {instant claims 12-15} (col. 19, line 39). At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the chelating agent of Plank with the invention of Poncelet, and the motivation would be, as Plank suggests, improving attrition resistance of the product (col. 19, line 37).

17. Campbell and Poncelet are analogous art because they from similar problem solving area in relation to polymeric aluminosilicate material. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the aluminosilicate polymeric material of Poncelet with the invention of Campbell, and the motivation would be, as Poncelet suggests, providing a permeable and antistatic coating layer (col. 2, line 15).

18. Claim 16: Campbell teaches that the particle to binder ratio to be 1:1 to 15:1 [0032], which is calculated to be 50-93.7% of particles.

19. Claim 17: Campbell teaches the binder can be gelatin or polyvinyl alcohol [0031].

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
September 6, 2008.

/Betelhem Shewareged/
Primary Examiner, Art Unit 1794.